



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

sim

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,742	08/10/2001	Joseph E. Kaminkow	IGT1P061/P-573	7305

22434 7590 09/19/2002

BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY, CA 94704-0778

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,742

Applicant(s)

KAMINKOW, JOSEPH E.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-57, drawn to method of awarding player-tracking points, classified in class 463, subclass 25.
 - II. Claims 58-85, drawn to method for validating loyalty instruments, classified in class 463, subclass 25.
 - III. Claims 86-97, drawn to a gaming machine, classified in class 463, subclass 21.
 - IV. Claims 98-103, drawn to a loyalty program network, classified in class 463, subclass 42.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced by hand -- i.e., at a gaming table with dealer intervention instead of automatically by a gaming machine.
3. Inventions II and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced by a materially different apparatus -- a stand alone system instead of a network.

Art Unit: 3714

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with David Olynick on 11 September 2002 a provisional election was made without traverse to prosecute the invention of group 1, claims 1-57.

Affirmation of this election must be made by applicant in replying to this Office action.

Claim 58-103 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method For Issuing A Loyalty Program Instrument Or Ticket Redeemable For Prizes, Game Play Or Other Comps, To A Patron In A Gaming Establishment Without The Patron Initiating A Player Tracking Session.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Art Unit: 3714

8. Claims 1-3, 5-17, 19-22, 24-27 & 29-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US Patent Number 6,379,247).

Claims 1, 14: Walker teaches a method for awarding player-tracking points to patrons of a gaming establishment. (Abstract & Title) The dealer determines when the patron has begun an activity for which player tracking points/comps are accrued and accrues the points to the player without the player initiating a player tracking session. (Fig 10a) The player is awarded the accrued points. (Fig 10b, 1038)

Claims 2, 16: The gaming establishment is a casino. (Title)

Claims 3, 17: The gaming entity has a plurality of venues – i.e., gaming tables (112).

Claims 5, 19: Walker teaches that the player may receive player tracking points for playing “blackjack, craps, roulette, poker, and the like.” (Col 3, 50-52) These are games of chance.

Claims 6, 26, 27: Fig 10a shows that the player tracking points begin accruing without receiving player tracking information or a player tracking card from the player.

Claim 7: The player has a player tracking account with the gaming establishment. (Fig 9)

Claims 8, 29: The patron has a player tracking account with the casino. (Fig 9) The player tracking points may be awarded to the patron anonymously, without crediting the player tracking account. (Col 8, 18-20)

Claims 9, 30: In one embodiment, the player is awarded frequent flyer miles without reference to the player account. (Col 10, 23-33) The player merely informs the casino which frequent flyer account (as opposed to casino player tracking account) the frequent

flyer miles should be assigned to. (Col 10, 31-33) Frequent flyer miles can be considered to be “comps”.

Claim 10: The player tracking points are stored on a loyalty program instrument. (Fig 10b, 1036)

Claims 11, 31: Walker teaches crediting the player tracking points stored on the loyalty program instrument to a player tracking account of the patron. (Col 12, 5-20 & 55-67)

Claims 12, 33: Walker teaches that the loyalty point instrument is a printed ticket. (Col 5, 28-32)

Claims 13, 21, 22: The activity for which player-tracking points accrue (playing a gambling game) occurs in a venue within, and therefore, affiliated with, the gaming establishment – i.e. gaming table (112).

Claim 15: Walker teaches a method for awarding player-tracking points to patrons of a gaming establishment. (Abstract & Title) The dealer determines when the patron has begun an activity for which player tracking points/comps are accrued and accrues the points to the player without the player initiating a player tracking session. (Fig 10a) The player is awarded the accrued points. (Fig 10b, 1038) which is issued to the player. (Fig 10b, 1036, 1038) Fig 10a shows that the player tracking points accrue without receiving player tracking information from the player.

Claim 20: The activity for which a patron may receive player-tracking points is an entertainment purchase – i.e., gambling. Gambling is entertainment.

Claim 24: Walker teaches that the loyalty points stored on the loyalty instrument are redeemable for comps. (Col 12, 55-67)

Claim 25: The rate at which the patron accrues loyalty points varies according to the amount wagered. (Col 4, 39-65)

Claims 32, 35: The loyalty points are credited to the patron's player tracking account or redeemed for comps using a cashier station. (Col 3, 59-62)

Claim 34: The loyalty program instrument is designed to store a validation number. (Fig 10b, 1112)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 18, 36-41, 44-46, 48-53 & 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker as applied to claim 1 or 15 (as appropriate) in view of Cumbers (US Patent Number 6,142,876).

Claims 4, 18: Walker teaches the invention substantially as claimed, but does not teach applying the system to gaming machines. Cumber, another system for awarding comps without direct player input, teaches awarding comps for play on gaming machines.

Casinos have many patrons who play gaming machines. Of these, many play only at the gaming machines. Gaming machines are a source of tremendous profit for the casino.

Casinos have found that awarding comps to players increases the likelihood that the player will return to the casino to gamble in the future. It would have been obvious to one of ordinary skill in the art at the time of the invention to have awarded player

Art Unit: 3714

tracking points to patrons who play gaming machines in order to increase the likelihood that the player will return to the casino to gamble in the future, thus ensuring future profits.

Claim 36: Walker teaches detecting a first game event initiated by the game player (a bet) and accruing loyalty points in response thereto. (Col 2, 63-65) Walker teaches determining a second gaming event – player decides to stop playing. (Fig 10a, 1022) The system determines the total number of loyalty points that have accrued to the game player and issues the player a loyalty point instrument designed to store the awarded loyalty points. (Figs 10 a & b) The system issues loyalty points without receiving identification from the game player.

Walker does not teach applying the system to gaming machines. Cumbers, another system for awarding comps without direct player input, teaches awarding comps for play on gaming machines. Casinos have many patrons who play gaming machines. Of these, many play only at the gaming machines. Gaming machines are a source of tremendous profit for the casino. Casinos have found that awarding comps to players increases the likelihood that the player will return to the casino to gamble in the future. It would have been obvious to one of ordinary skill in the art at the time of the invention to have awarded player tracking points to patrons who play gaming machines in order to increase the likelihood that the player will return to the casino to gamble in the future, thus ensuring future profits.

Claims 37, 40: The loyalty program instrument is designed to store a validation number. (Fig 10b, 1112) This is information.

Art Unit: 3714

Claim 38: Walker teaches that the loyalty point instrument is a printed ticket. (Col 5, 28-32)

Claim 39: Walker teaches that the first event is placing a wager. This is analogous to depositing an indicia of credit into a gaming machine.

Claim 41: Walker teaches issuing a loyalty program instrument when the player decides to leave the game. (Fig 10a, 1022) This is analogous to detecting a player request for a loyalty program instrument or detecting zero credits.

Claim 44: Walker teaches displaying the amount of loyalty points to the game player. (Fig 10a, 1018)

Claims 45 & 46: Walker teaches storing loyalty point transaction information on a memory device (416) located at the gaming table. The gaming table is analogous to the gaming machine. The device is on, but not inside the gaming table. (Fig 3)

Claim 48: Walker's Fig 10a clearly discloses that game play sequences for one or more games may be presented between the first and second gaming events.

Claim 49: Walker teaches that the player may receive player tracking points for playing "blackjack, craps, roulette, poker, and the like." (Col 3, 50-52) These are games of chance. The video versions of these games are notoriously well known.

Claim 50: The rate at which the patron accrues loyalty points varies according to the amount wagered. (Col 4, 39-65)

Claims 51, 52: Fig 10a shows that the player tracking points begin accruing without receiving player tracking information or a player-tracking card from the player.

Art Unit: 3714

Claim 53: Walker teaches issuing a loyalty program instrument (i.e., a receipt). (Fig 10b, 1038) This is performing a loyalty program instrument transaction.

Claim 55: Walker teaches that the accrued loyalty points are determined by a logic device (Fig 4, 410) located on the gaming table. This is analogous to being located on the gaming machine.

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker as applied to claim 22 above, and further in view of Boushy (US Patent Number 5,761,647).

Claim 23: Walker teaches the invention substantially as claimed. Walker does not teach communication between venues and the gaming establishment via the Internet. Boushy teaches a national customer recognition system in which various gaming venues communicate with a gaming establishment via a Wide Area Network (102). The Internet is a well-known Wide Area Network. Linking several venues via a Wide Area Network allows players to accumulate points at affiliated casino properties. This encourages patrons to visit affiliated casinos as they travel about the world. This translates to higher profits within a family of casinos. It would have been obvious to one of ordinary skill in the art at the time of the invention to have communication between venues and the gaming establishment via the Internet in order to create a national customer recognition that allows players to accumulate points at affiliated casino properties thus encouraging patrons to visit affiliated casinos as they travel about the world and generating to higher profits within a family of casinos.

Art Unit: 3714

12. Claims 42, 43, 54, 56, & 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and Cumbers as applied to claim 36 above, and further in view of Burns et al. (US Patent Number 6,048,269).

Claim 42: Walker and Cumbers teach the invention substantially as claimed. Walker teaches determining the amount of loyalty points stored on a first loyalty point instrument and validating the first loyalty point instrument. When the first loyalty point instrument has been validated, the loyalty points stored thereon are added to an amount of loyalty points awarded to the game player. (Fig 11) Walker, however, teaches that the redemption/validation process occurs at a cashier station instead of at a gaming machine. Burns teaches reading tickets that are analogous to the loyalty point instrument at the gaming machine. This provides greater convenience to the player by allowing the player to redeem the loyalty point instruments at more locations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have allowed players to redeem/validate loyalty point instruments at a gaming machine in order to provide greater convenience to the player.

Claim 43: Walker and Cumbers teach the invention substantially as claimed. Walker, however, teaches the loyalty point instruments are input by the cashier. Burns teaches a ticket reader (206). Having a ticket reader handle the input instead of a cashier reduces costs to the casino because they do not have to have as many employees. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the loyalty point instrument input using a ticket reader in order to reduce the number of employees a casino needed, thus reducing costs.

Art Unit: 3714

Claim 54: Walker and Cumber teach the invention substantially as claimed, but do not specifically teach redeeming the comps earned for plays on the gaming machine. Burns teaches redeeming free play tickets (Fig 3) for a particular game. (Col 5, 46-65) Free play on a gaming machine is often given as comps. This allows the casino to give the player a loyalty award that keeps the player gambling. This boosts casino profits It would have been obvious to one of ordinary skill in the art at the time of the invention to have allowed the loyalty program instrument to be redeemed for play on a gaming machine in order to keep players gambling, thus increasing casino profits.

Claim 56: Walker and Cumber teach the invention substantially as claimed, but do not teach configuring the game machines to communicate loyalty program information to a second gaming machine. Walker teaches issuing a ticket with loyalty program information. Burns teaches that the tickets issued by a gaming machine can be used to communicate with other gaming machines. Allowing players to use tickets issued by one gaming machine on another gaming machine encourages a player to continue gambling. It would have been obvious to one of ordinary skill in the art at the time of the invention to have configured the game machines to communicate loyalty program information to a second gaming machine in order to encourage the players to continue gambling, thus increasing casino profits.

Claim 57: It is well known for players to play two different gaming machines simultaneously. Obviously, the player would accrue loyalty points on both machines. Walker teaches issuing a single ticket representing the combined loyalty points awarded in a number of games. (Figs 10a & b) Walker also teaches that the player may receive a

number of receipts, each representing an amount of loyalty points awarded. (Col 12, 15-20) Walker teaches communicating the number of loyalty points awarded to a central location (the cashier's terminal) where they are combined. (Figs 11 - 12)

Walker and Cumber teach the invention substantially as claimed, but do not teach configuring the game machines to communicate loyalty program information to a second gaming machine or printing a combined loyalty program instrument from the second gaming machine. Walker teaches issuing a ticket with loyalty program information. Burns teaches that the tickets issued by a gaming machine can be used to communicate with other gaming machines. Allowing players to use tickets issued by one gaming machine on another gaming machine encourages a player to continue gambling. When the player is finished with the second gaming machine, it prints out a single consolidated ticket. This increases player convenience because the player only has to keep up with one ticket. It would have been obvious to one of ordinary skill in the art at the time of the invention to have configured the game machines to communicate loyalty program information to a second gaming machine in order to encourage the players to continue gambling, thus increasing casino profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have printed out a single consolidated loyalty program instrument in order to increased player convenience by reducing the number of tickers the player would have to keep up with.

13. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and Cumbers as applied to claim 36 above, and further in view of Kelly et al. (US Patent Number 5,816,918).

Art Unit: 3714

Claim 47: Walker and Cumbers teach the invention substantially as claimed. Both Walker and Cumbers disclose that the comps may take many forms, but neither teaches the details of redeeming comps in forms other than as frequent flyer miles. Kelley teaches a prize redemption system that displays a prize menu including one or more prizes redeemable for an amount of loyalty points. (Fig 6, 334) The system then receives a prize selection selected from the prize menu. (336) If the patron has enough loyalty points for the selected prize, the system issues a loyalty program instrument used to redeem the selected prize. (337) It would have been obvious to one of ordinary skill in the art at the time of the invention to have a prize menu from which a player may choose a prize and issue a loyalty program instrument redeemable for that prize (providing the player has enough loyalty points to purchase the prize) in order to implement Walker's and Cumbers' disclosure that comps may be redeemed for a number of goods and services.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	US Patent Number	Applicability
Shoemaker	6,161, 743	Game machine issues tickets
Saunders	6,280,326	Redeeming tickets at gaming machines
Rowe	6,394,907	Redeeming tickets at gaming machines
Hogan	6,267,671	Another comps system
The Straight Dope	N/A	S&H Green Stamps ® history – loyalty program instruments redeemable for virtually anything
S&H Greenpoints ® web page	N/A	S&H Green Stamps ® history, menu of prizes, loyalty program instruments

Art Unit: 3714

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cbc

September 12, 2002


JESSICA HARRISON
PRIMARY EXAMINER